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No. 84-1170

IN THE

Supreme Court of the United States

OCTOBER TERM, 1985

20TH CENTURY WEAR, INC.,

Petitioner,

vs.

SANMARK-STARDUST INC. and
DOMINO INDUSTRIES, INC.,

Respondents.

REPLY BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT

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This brief is respectfully submitted in further support of the petition for a writ of certiorari by 20th Century Wear, Inc. ("20th Century") and in response to certain of the statements made by respondent Sanmark-Stardust Inc. and Domino Industries, Inc. (the "Sanmark defendants") in their brief in opposition.

I. This Is No "Ordinary" Trademark Case.

The statement by the Sanmark defendants that "this is an ordinary trademark and unfair competition action" (Resp. Brief at 1) is inconsistent with, and disputed by, the twenty-one (21)

page opinion of the Second Circuit, which opinion we believe will have far-reaching and adverse consequences for the federal trademark system and the enforceability of registered trademarks.

20th Century's Petition for a Writ of Certiorari is based on the Second Circuit's failure to accord 20th Century's registered trademark the strong presumption of validity to which it is statutorily entitled, the Second Circuit's failure to follow the "clearly erroneous" standard applicable to its review of District Court determinations and the Second Circuit's failure to require the respondent trademark infringer to establish the allegedly descriptive nature and meaning of the mark in the mind of the consuming public at the time of the infringement. These defects in the Second Circuit's opinion make this anything but an ordinary trademark case. In short, the viability of the federal trademark system vis-a-vis small businesses and their consumers and the long accepted standard for review of lower court determinations are at stake.

II. The Second Circuit Has Finally Determined The Issues On Which 20th Century Seek A Writ Of Certiorari.

The argument advanced by the Sanmark defendants that the United States Supreme Court should not grant certiorari because there has not been a final decision in this case is makeweight. The Second Circuit has made a final determination on the issues described above and discussed in 20th Century's Petition. These issues, as determined by the Second Circuit, affect the viability and strike at the very heart of the federal trademark system. There will be no re-trial on these issues. Accordingly, based on the Second Circuit's final determination of these crucial issues, 20th Century's Petition for a Writ of Certiorari is entirely appropriate.

III. There Is A Conflict Among The Circuits.

Respondent has failed to address the cases referenced in the Second Circuit's Opinion and those cited in Callmann's Treatise, which clearly demonstrate that there is, indeed, a conflict among the circuits.

In this connection, the recent decision by the Fourth Circuit in *Pizzeria Uno Corporation v. Temple*, 224 U.S.P.Q. 185 at 188 (4th Cir. 1984), in which the Court candidly admitted the difficulty federal courts are experiencing in drawing the distinction between descriptive and suggestive marks, is worth emphasizing. There, the Court concluded that because of the difficulty in determining whether a mark is descriptive or suggestive, many courts confronted with the problem conclude that it is 'especially prudent "to give due respect to the determination of the [United States Patent and Trademark Office]". . . .' *Id.* at 188. No such respect was afforded by the Second Circuit to the determination by the United States Patent and Trademark Office that 20th Century's Trademark was suggestive, and accordingly entitled to registration and the protections afforded a duly registered trademark.

CONCLUSION

For the reasons advanced in 20th Century's Petition for a Writ of Certiorari and above, petitioner requests that its Petition for a Writ of Certiorari be granted.

Dated: New York, New York
February 26, 1985

Respectfully submitted,
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